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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,330	02/06/2004	Gregory R. Furnish	59472.22104	8531
36734 7590 01/21/2009 BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304				
EXAMINER				
MAL HAO'D				
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3732				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/774,330

**Applicant(s)**

FURNISH ET AL.

**Examiner**

HAO D. MAI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27, 28, 30, 33-36 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27, 28, 30, 33-36 and 47-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The drawings fail to show the combination of the embodiment of Figure 7 (claimed in independent claim 27) and the embodiment of Figure 5 (claimed in dependent claims 34-36). Therefore, such combination of the two embodiments must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112, first paragraph***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 34-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Note that the present application contains at least two distinct embodiments: (1) the embodiment of Figures 5, 5A-5D, and (2) the embodiment of Figure 7. Claims 34-36 are directed to the means for removable mounting the bifurcated member 30 to the handle shown in the embodiment of Figures 5 and 5A-5D. Claims 27 and 28 are no longer generic as originally claimed since the socket 68 at the end of shaft 80 shown in embodiment of Figure 7 has been incorporated therein. In another word, independent claim 27 is directed to Figure 7 while dependent claims 34-36 are directed to Figure 5.

The specification does not provide enablement for the combination of both the embodiments of Figure 5 and Figure 7. Particularly, the means for mounting the bifurcated member to the handle segment are mutually exclusive between the two embodiments of Figures 5 and Figure 7.

***Claim Rejections - 35 USC § 112, second paragraph***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 34-36 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 34 and 47 each recites the limitation "said connecting member", which lacks antecedent basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 27-28, 30, 33, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Heifetz (4,606,522) in view of Barish et al. (3,240,516).**

**Regarding claim 27,** Heifetz discloses a stabilizer comprising:

- a. a bifurcated member 13 having two elongated prongs 51, 52, each prong having a proximal end and an opposite distal end, said prongs attached to each other adjacent the proximal ends thereof, at least a portion of each prong is capable of engaging a heart of a patient and wherein the prongs of said bifurcated member are attached to each other by means of a connecting member (horizontal bar 13 between 20 and 22), said connecting member having opposed ends in which each end is fixedly attached to one prong adjacent its proximal end (Fig. 1);
- b. an elongated handle segment consisted of structures 20, 21, 11, and 12; the handle having a first end 12 and an opposite second end towards reference numeral 20 (Figs. 1-2);
- c. a longitudinally-extending bore 22/23/41 within said handle;

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- d. a ball 43 disposed within said bore adjacent the first end 12 of said handle segment, a portion of said ball fixedly attached to said bifurcated member 13 via member 42, wherein the bore and the ball form a connection that allows said bifurcate member to rotate and pivot relative to said handle segment so that said bifurcated member is movable to a desired position (Figs. 1, 4).
- e. a shaft 55/56 having an upper end and an opposite lower end such that at least a portion of said shaft is complementarily received within said bore (Fig. 1);
- f. a threaded surface 62 located on the shaft 55/56; wherein a portion 63 of bore 22/23 engages the threaded surface 62 of said shaft so that the interface there between controls the relative movement between said shaft and said bore as said shaft is moved within said bore.

Heifetz disclose the invention substantially as claimed except for a socket attached to the lower end of the shaft, the socket having an interior surface of a size to complementarily and detachably engage the ball. Barish et al. disclose a socket 74 attached to the lower end of the shaft 40, said socket having an interior surface of a size to complementarily and detachably engage said ball (Fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Heifetz by incorporating a socket as taught by Barish et al. to the end of the shaft in order to provide an interior surface of the socket that would better complementarily engages the exterior of ball.

**As to claim 28**, Heifetz shows that the ball 43 is movably secured within said bore, portion 41 so that the ball 43 and attached bifurcated member 13 are rotatably and pivotally movable relative to said handle without separating therefrom (Figs. 1, 4). **As to claims 30**, Barish's socket 74 at the end of Heifetz's shaft portion 23 is within the handle bore and can have an engaged position (when frictionally attached to the ball), in which the interior surface of said socket detachably engage said ball to frictionally hold said ball in the desired position, and a disengaged position (when detached from ball), in which the interior surface of said socket

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and said ball are spaced apart so that said ball is movable. **As to claim 33**, Heifetz shows the tightener 61 fixedly attached to the upper end of the shaft and is disposed outside of the bore, wherein rotation of said tightener moves shaft and Barish's incorporated socket between the engaged and disengaged portion.

**Regarding claim 48**, Barish/Heifetz disclose all the claimed elements as detailed above with respect to claim 27.

**8. Claims 34-36, 47, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Heifetz in view of Barish et al., and further in view of Hulterstrum (3,433,510).**

Heifetz/Barish disclose the invention substantially as claimed. Heifetz in particular disclose a terminal link 12 on the handle having a swivel seat 41 for mounting the ball and the attached bifurcated member 13. Heifetz/Barish thus fail to disclose the means for removably mounting the bifurcated member onto the handle (claims 34, 47, 49). Heifetz/Barish further fail to disclose such means comprising an opening disposed intermediate the first and second ends of the handle for allowing the ball to traverse therethrough (claims 35-36).

Hulterstrum disclose a swivel joint 10 having an opening 56 for removably mounts ball 24 and its attached tool 32 onto handle 14. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Heifetz/Barish by substituting Heifetz's terminal link 12 with Hulterstrum's universal swivel joint 10 with the opening 56 in order to provide a means for removably mounting the ball and its attached bifurcated member onto the handle. Such modification is a substitution of suitable alternative material/mechanism that would yield predictable and/or optimum results.

***Response to Arguments***

9. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection necessitated by amendments to the claim(s). Note that the amendment to include "a threaded surface located on said shaft" to claim 1 is not the same as the limitation(s) previously claimed in claim 32.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Hao D Mai/  
Examiner, Art Unit 3732**

/Cris L. Rodriguez/  
Supervisory Patent Examiner, Art Unit 3732